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DIPE JC
FEB 28 2001
PATENT & TRADEMARK OFFICE

MAR 05 2004

Group Art Unit: 1616

RECEIVED

Sir:

☐ A Small Entity Statement Was Previously Submitted In This Application.
☐ A Small Entity Statement Is Enclosed.
☐ A Filing Fee For Extra Claims Does Not Appear Required.
☒ A Filing Fee For Extra Claims Is Calculated Below:

	No. of Claims Remaining After <u>Amendment</u>	Highest No. of Claims Previously Paid For	No. of Extra Claims	Fee For Small Entity <u>Rate</u>	<u>Fee</u>	Fee For Other Than Small Entity <u>Rate</u>	<u>Fee</u>
Total	21	20	1	x \$ 9	= \$	x \$18	= \$18
Independent	3	3	0	x \$ 40	\$	x \$80	= \$
First Presentation of Multiple Dependent Claims				+ \$135	= \$	+ \$270	= \$
				TOTAL = \$		TOTAL = \$ 18.00	

- ☒ It is hereby petitioned that any required extension of time be granted for filing the Response. An extension of two (2) month(s) having a fee of \$390.00 appears required.
- ☒ A check in the amount of \$408.00 is attached. Please credit any overpayment to Deposit Account 16-2563 of Alix, Yale & Ristas, LLP.
- ☒ The Commissioner is hereby requested and authorized to charge Deposit Account 16-2563 of Alix, Yale & Ristas, LLP for any fee, not enclosed herewith, due for any reason in connection with the amendment or this or any other document accompanying the amendment, including (a) any filing fees under 37 CFR 1.16 for the presentation of extra claims and (b) any patent application processing fees under 37 CFR 1.17. ☒ A duplicate copy of this sheet is attached.

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Signature: 
James E. Piotrowski

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Date: February 26, 2001



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:
Alexandros MAKRIYANNIS et al

Serial No. 09/328,742

Examiner: A. Pryor

Filing Date: June 6, 1999

Group Art Unit: 1616

For: INHIBITORS OF ANANDAMIDE TRANSPORTER AS ANALGESIC AGENTS

Commissioner for Patents
Washington, DC 20231

10/10/98
3/10/98
3/6/01

Sir:

RESPONSE TO OFFICE ACTION

In response to the Office Communication dated September 25, 2000,
Applicants respectfully request entry of the following amendment and consideration
of the following remarks.

AMENDMENT

In the claims:

Please add the following claim.

--21. The method of claim 1 wherein X is a hydrophobic aliphatic hydrocarbon
chain containing 19 carbon atoms and having 4 nonconjugated cis double bonds in
the middle portion of the chain and Y is an amide radical. --

REMARKS

Claim 21 has been added. No claims have been cancelled or amended.

Upon entry of the amendment claims 1-21 will be pending in the application. The

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01 FC:116 390.00 OP

03/01/2001 SSITHIB1 00000104 09328742

02 FC:103 18.00 OP

new claim is supported by the application, for example in Table I therein.

RESPONSE TO RESTRICTION OR ELECTION REQUIREMENT

The September 25, 2000 Office Communication stated the application contained patentably distinct species of the claimed invention and imposed an election requirement under 35 U.S.C. §121 to a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. The Communication states that claim 1 (a method of inhibiting transport of anandamide comprising the administration of compound X-Y-Z) is generic.

Applicants note that the language stated to be generic in the Office Communication strictly applies only to claims 1-9. Claims 10-11 do not use the recited language while claims 12-20 recite a pharmacological formulation comprising a compound represented by the following structural formula: X-Y-Z ... Applicants respectfully ask the Examiner to clarify the election requirement as it applies to claims 10-11 and 12-20.

MPEP §803.02 states (underlining added) "If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all claims on the merits, even though they are directed to independent and distinct inventions." The Examiner has not shown or even asserted it would be a "serious burden" to perform a search and examination of all of Applicants' claims. Since the Examiner has not made any showing that the examination of all of Applicants' claims would be a "serious burden", the requirement for restriction is respectfully traversed and the Examiner is respectfully urged to withdraw the same and examine all of claims 1-21 as mandated by the MPEP.

In order to strictly comply with the election requirement Applicants' provisionally elect a species wherein X is a hydrophobic aliphatic hydrocarbon chain containing 19 carbon atoms and having 4 nonconjugated cis double bonds in the middle portion of the chain and Y is an amide radical. Under this provisional election

claim 1 is generic and claims 2,3,5,6,7,8,9 and 21 read on the provisionally elected species.

Applicants' believe the above response is fully responsive to the Election Requirement imposed in the September 25, 2000 Office Communication. In the event that the Examiner should assert that a further election of a single Z species is required Applicants traverse such an assertion for the reasons given above. Should the Examiner maintain that a single Z species is required Applicants provisionally elect, with traverse, the species wherein Z is a hydroxy substituted aryl radical. Under this provisional election claim 1 is generic and claims 2,3,5,6,7 and 21 read on the provisionally elected species.

Respectfully submitted,

Alexandros MAKRIYANNIS et al

By



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